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| Appellants: | John W. Hoffman; Patrick J. Nahm | Docket No.: | 18,996 |
| Serial No.: | 10/750,016 | Group: | 1733 |
| Confirmation No.: | 9322 | Examiner: | Christopher Schatz |
| Filed: | December 30, 2003 | Date: | August 23, 2006 |
| For: | Method And Apparatus For Applying An Elastic Member | | |

Appeal Brief Transmittal Letter

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. 41.37, transmitted herewith is an Appeal Brief pursuant to the Notice of Appeal which was mailed on June 23, 2006.

Please charge the \$500.00 fee (fee code 1402), pursuant to 37 C.F.R. 41.20(b)(2), which is due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

Respectfully submitted,

JOHN W. HOFFMAN ET AL

By: 

Randall W. Fieldhack
Registration No.: 43,611

CERTIFICATE OF TRANSMISSION

I, Mary L. Marchant, hereby certify that on August 23, 2006 this document is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300.


Mary L. Marchant

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Brief on Appeal to the Board of Patent Appeals and Interferences

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. 41.37 Appellants respectfully submit this Brief in support of their Appeal of Examiner Schatz's **Final Rejection** of claims 1, 3-9, 13, and 14 which was mailed on March 24, 2006.

On June 23, 2006, Appellants, pursuant to 37 C.F.R. 41.31 mailed a timely Notice of Appeal. Thus, the time period for filing this Brief ends on August 23, 2006.

Real Party in Interest

The present Application has been assigned to the Kimberly-Clark Worldwide, Inc.

Related Appeals and Interferences

There are no related appeals and/or interferences with regard to the present Application.

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Status of Claims

Claims 1, 3-9, 13, and 14 remain in the application with claims 1, 3-9, 13, and 14 being finally rejected. Claims 10-12 have been withdrawn and claims 2 and 15-20 have been canceled.

Status of Amendments

No amendments were filed after the final Office Action mailed March 24, 2006.

Summary of Claimed Subject Matter

The following summary correlates claim elements to specific embodiments described in the application specification, but does not in any manner limit claim interpretation. Rather, the following summary is provided only to facilitate the Board's understanding of the subject matter of this appeal.

Independent claim 1 is directed to a method for applying an elastic member (30) to an article web (20), as representatively illustrated, for example, in Figs. 1-3. The article web (20) defines a pair of article web side edges (22). Page 6, lines 30-36. The method includes providing the elastic member (30) including providing an elastic material web (24) page 12, lines 13-20; forming a line of weakness (74) in the elastic material web (24) to define a trailing edge (38) of the elastic member (30) page 12, line 29 to page 13, line 9; cutting the elastic material web (24) to define an leading edge (37) of the elastic member (30) page 12, line 29 to page 13, line 9; and separating the elastic material web (24) at the line of weakness (74) into discrete elastic members (30) page 12, line 29 to page 13, line 9. At least a portion of the elastic member (30) is elongatable in at least a cross machine direction and defines an elastic member width. Page 15, lines 24-37. The method also includes moving the elastic member (30) in a machine direction along an elastic member web path (26). Page 16, lines 16-23. The method further includes providing a pair of rotatable wheels (42, 44) in the elastic member web path (26). Page 6, lines 15-28. The pair of wheels (42, 44) defines a pair of inboard edges (46), a pair of outboard edges (48) opposite the inboard edges (46), an elastic member entry location (50)

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having an elastic member entry location width that is less than the elastic member width, and an elastic member exit location (52) having an elastic member exit location width that is greater than the elastic member entry width. Page 6, lines 15-28; page 7, lines 1-9.

The method also includes engaging the elastic member (30) with the pair of wheels (42, 44) at the elastic member entry location (50) wherein a portion of the elastic member (30) is located beyond each of the inboard edges (46) of the pair of wheels (42, 44) thereby defining a pair of outboard portions (32) of the elastic member (30) and an inboard portion (34) of the elastic member (30). Page 10, line 34 to page 11, line 10; page 17, lines 25 -28. The method further includes rotating the elastic member (30) with the pair of wheels (42, 44). Page 10, line 34 to page 11, line 10; page 17, lines 25 -28. The method finally includes applying the elastic member (30) to the article web (20) proximate the elastic member exit location (52) wherein the outboard portions (32) of the elastic member (30) extend beyond the article web side edges (22). Page 16, line 31 to page 17, line 12.

Dependent claim 14 is directed to the method of claim 1 wherein the pair of wheels (42, 44) each further define a wheel diameter of from between 0.3 meters to 2.0 meters. Page 7, lines 25-32.

Grounds of Rejection to be Reviewed on Appeal

Ground 1

Claims 1, 3-9, and 13 stand rejected under 35 U.S.C. § 103(a) as being obvious and thus unpatentable over U.S. Patent No. 6,336,922 issued January 8, 2002 to VanGompel et al. (hereinafter "VanGompel") and further in view of U.S. Patent No. 5,308,345 issued May 3, 1994 to Herrin (hereinafter "Herrin"), U.S. Patent No. 4,943,340 issued on July 24, 1990 to Ujimoto et al. (hereinafter "Ujimoto"), PCT Patent Application Publication No. WO 02/13741 published on February 21, 2002 to Coenen et al. (hereinafter "Coenen"), and optionally in view of U.S. Patent Application Publication No. US 2001/0042591 published on November 22, 2001 to Milner et al. (hereinafter "Milner"). Under Ground 1, claims 1, 3-9, and 13 are argued as a group.

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Ground 2

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being obvious and thus unpatentable over VanGompel, Herrin, Ujimoto, Coenen, and Milner, and further in view of U.S. Patent No. 5,560,793 issued October 1, 1996 to Ruscher et al. (hereinafter "Ruscher"). Under Ground 3, claim 14 is argued alone.

Argument

Ground 1 – Rejection Of Claims 1, 3-9, and 13

Claims 1, 3-9, and 13 stand rejected under 35 U.S.C. § 103(a) as being obvious and thus unpatentable over VanGompel, Herrin, Ujimoto, Coenen, and optionally Milner. Appellant respectfully submit that the Examiner's rejection is improper and should be reversed.

To establish a *Prima Facie* case of obviousness, the Examiner must meet three basic criteria: (1) the Examiner must show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) the Examiner must show a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

Applicants submit that the Examiner has provided no suggestion or motivation as to why one of ordinary skill in the art would combine the teachings of VanGompel, Herrin, Ujimoto, and Coenen as suggested by the Examiner. That is, the Examiner has not provided any reasoning why one of ordinary skill in the art would combine the teachings of VanGompel (for an absorbent article with an elastic member, as suggested by the Examiner) with the teachings of Herrin (for a method for applying an elastic member, as suggested by the Examiner) further with the teachings of Ujimoto (for a method of providing an elastic web material) and further with the teaching of Coenen (for the formation of a line of weakness, as suggested by the Examiner). Instead, the Examiner asserts in piecemeal fashion why one would look from one reference to another, but does not provide any motivation or suggestion why one would collectively assemble these references to arrive at the present invention. In fact, the Examiner

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appears to acknowledge as much by further adding the teachings of Milner to the teachings of Coenen on page 6-7 of the Office Action Mailed October 5, 2005, since Coenen is directed to the formation of a leg elastic.

As an example, the Examiner states on page 4 of the October 5, 2005 Office Action that there is motivation to combine Ujimoto with Herrin because Ujimoto's cutting a web of elastic material into individual pieces "simplifies the production process," implying that Ujimoto simplifies the production process of Herrin. Ujimoto does not do this because Herrin and Ujimoto apply the same process: both cut an elastic web into pieces (Ujimoto: col. 4, lines 52-57; Herrin: col. 3, lines 36-40), both attach the elastic piece to a web (Ujimoto: col. 6, lines 19-34; Herrin: col. 4, lines 46-51), and both cut the web such that part of each elastic piece is attached to succeeding web pieces (Ujimoto: col. 6, lines 44-53; Herrin: col. 2, lines 42-48). As a result, there can be no motivation to look to one of Ujimoto or Herrin to simplify the process of the other and these references are not properly combinable. Yet the Examiner still needs pieces of Ujimoto; the Examiner is left with the dilemma of needing to pick pieces of Ujimoto and Herrin to assemble part of the Applicants' claimed invention, yet having no apparent motivation, teaching, or suggestion to combine the references.

As another example, a similar leap in logic is applied to the alleged motivation in adding Coenen to the combination. The Examiner states that applying Coenen's process of forming a line of weakness prior to cutting an elastic piece "makes the separation of the elastic material web easier," implying that the teaching of Coenen would make the processes of Ujimoto or Herrin easier. Coenen does not do this. Coenen merely states at page 10, lines 22-24 that cutting a web at a line of weakness is easier than cutting the same web without the line of weakness, an apparently logical statement. Coenen does not teach that the separation process of forming a line of weakness and then separately cutting the web at that line of weakness (Coenen's process) is easier than the separation process of merely cutting the web once (Ujimoto's and Herrin's processes). As a result, there can be no motivation to look to Coenen to make easier the processes of Ujimoto or Herrin and these references are not properly combinable. The Examiner is again left with the dilemma of needing to pick pieces of Coenen, Ujimoto, and Herrin to assemble part of the Applicants' claimed invention, yet having no apparent motivation, teaching, or suggestion to combine the references.

Indeed, it appears that the Examiner is improperly relying on hindsight based on the teachings

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of the present invention to suggest that one of ordinary skill in the art would be motivated to combine the above references in the manner suggested. That is, it appears that the Examiner is improperly utilizing Applicant's disclosure as a road map for picking and choosing amongst a universe of potential configurations to arrive at the distinctive changes and modifications needed to further derive Applicant's claimed invention. In particular, the Examiner relies on four, and optionally a fifth reference to arrive at the present invention. Applicants respectfully submit that the motivation for why one of ordinary skill in the art would select just the right element required by the Examiner from four and perhaps five different references to arrive at the present invention has not been provided. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

For at least these reasons, Applicants submit that claim 1 is patentable over the combination of VanGompel, Herrin, Ujimoto, Coenen, and optionally Milner. Moreover, claims 3-9, which all eventually depend from claim 1, are likewise patentable over the combination of VanGompel, Herrin, Ujimoto, Coenen, and optionally Milner.

Further, and with respect to claim 8, the Examiner states on Page 6 of the Office Action dated October 5, 2005, that Fig. 2 of Herrin discloses an elastic member including a trailing edge defining a "w" shape. Fig. 2 of Herrin illustrates elastic folds 24 in a length 22 of rectangular elastic foam. Fig. 2 of Herring does not show an elastic member with a trailing edge in a "w" shape, it merely shows a bunched-up rectangle. Thus, Applicants respectfully submit that the combination of VanGompel, Herrin, Ujimoto, Coenen, and optionally Milner does not teach each and every element of claim 8, and for at least this additional reason, claim 8 is patentable over the combination of VanGompel, Herrin, Ujimoto, Coenen, and optionally Milner.

Ground 2 – Rejection Of Claim 14

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being obvious and thus unpatentable over VanGompel, Herrin, Ujimoto, Coenen, and Milner, and further in view of Ruscher. Appellant respectfully submit that the Examiner's rejection is improper and should be reversed.

Claim 14 depends from claim 1. As discussed above, the Examiner has failed to establish a

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prima facie case of obviousness over independent claim 1 in view of VanGompel in combination with Herrin, Ujimoto, Coenen, and Milner. Similarly, Applicants submit that the Examiner has not provided a suggestion or motivation why one would collectively look to VanGompel, Herrin, Ujimoto, Coenen, Milner, and Ruscher, and is rather picking and choosing from the prior art to arrive at the present invention.

Conclusion

For the reasons stated above it is Appellants' position that the Examiner's rejection of claims has been shown to be untenable and should be reversed by the Board.

Please charge the \$500.00 fee (fee code 1402), pursuant to 37 C.F.R. 41.20(b)(2), for filing this Appeal Brief to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875. Any additional prosecutorial fees which are due may also be charged to deposit account number 11-0875.

The undersigned may be reached at: (920) 721-8863

Respectfully submitted,


JOHN W. HOFFMAN ET AL.

By


Randall W. Fieldhack
Registration No.: 43,611

CERTIFICATE OF TRANSMISSION

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Mary L. Marchant

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Claims Appendix

The claims on appeal are:

1. A method for applying an elastic member to an article web defining a pair of article web side edges, said method comprising:

i) providing said elastic member, said providing comprising:

a) providing an elastic material web;

b) forming a line of weakness in said elastic material web to define a trailing edge of the elastic member;

c) cutting said elastic material web to define an leading edge of the elastic member; and

d) separating said elastic material web at said line of weakness into discrete elastic members, wherein at least a portion of said elastic member is elongatable in at least a cross machine direction and defines an elastic member width;

ii) moving said elastic member in a machine direction along an elastic member web path;

iii) providing a pair of rotatable wheels in said elastic member web path, said pair of wheels defining:

a) a pair of inboard edges,

b) a pair of outboard edges opposite said inboard edges,

c) an elastic member entry location having an elastic member entry location width that is less than said elastic member width, and

d) an elastic member exit location having an elastic member exit location width that is greater than said elastic member entry width;

iv) engaging said elastic member with said pair of wheels at said elastic member entry location wherein a portion of said elastic member is located beyond each of said inboard edges of said pair of wheels thereby defining a pair of outboard portions of said elastic member and an inboard portion of said elastic member;

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v) rotating said elastic member with said pair of wheels; and

vi) applying said elastic member to said article web proximate said elastic member exit location wherein said outboard portions of said elastic member extend beyond said article web side edges.

3. The method of claim 1 further comprising:

i) providing an adhesive application assembly; and

ii) applying an operative amount of adhesive to said elastic material web.

4. The method of claim 3 wherein said operative amount of adhesive is applied in a rectilinear pattern.

5. The method of claim 3 wherein said operative amount of adhesive is registered with said leading edge and said trailing edge.

6. The method of claim 3 wherein said operative amount of adhesive does not contact said pair of wheels.

7. The method of claim 1 wherein said trailing edge is curvilinear.

8. The method of claim 1 wherein said trailing edge defines "w" shape.

9. The method of claim 1 wherein engaging said elastic member comprises holding said elastic member on said pair of wheels with vacuum.

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13. The method of claim 1 wherein rotating said elastic member with said pair of wheels elongates said inboard portion of said elastic member at least 50%.

14. The method of claim 1 wherein said pair of wheels each further define a wheel diameter of from between 0.3 meters to 2.0 meters.

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Evidence Appendix

None.

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Related Proceedings Appendix

None.